

distinct warning light signals are generated alternatively in any combination of two or more visually distinct warning light signals.

42 46. (New) The multiple warning signal light of claim ²³27, wherein at least three visually distinct warning light signals are generated in any combination of three or more visually distinct warning light signals.

43 47. (New) The multiple warning signal light of claim ²³27, wherein at least three visually distinct warning light signals are generated simultaneously in any combination of three or more visually distinct warning light signals.

44 48. (New) The multiple warning signal light of claim ²³27, wherein at least three visually distinct warning light signals are generated alternatively in any combination of three or more visually distinct warning light signals.

REMARKS

In the Office Action of December 12, 2001, claim 1 was rejected pursuant to 35 U.S.C. §102(b) as being anticipated by Hall (U.S. Patent No. 5,585,783).

In addition, the Examiner rejected claims 2-6, 9-21, 23, and 25 pursuant to 35 U.S.C. §103(a) as being obvious in view of Hall '783.

Applicant wishes to thank the Examiner for the identification of allowable subject matter as contained within claims 7, 22, and 24.

With respect to 35 U.S.C. §102, the Federal Circuit has held that prior art is anticipatory only if every element of the claimed invention is disclosed in a single item of prior art, in the form literally defined in the claim. *Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, 225 U.S.P.Q. 253 (Fed. Cir. 1985); *Atlas Power Co. v. E.I. DuPont de Nemours*, 750 F.2d 1569, 24 U.S.P.Q. 409 (Fed. Cir. 1984); *American Hospital Supply v. Travenol Labs.*, 745 F.2d 1, 223 U.S.P.Q. 577 (Fed. Cir. 1984).

Applicant respectfully asserts that Applicant's claims as amended herein are not anticipated by the Hall '783 reference particularly with respect to the second panel being positioned over the pair of opposite sides, the second panel further comprising an opaque exterior

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surface, the second panel constructed and arranged to secrete said light emitting diode light sources. Further, Applicant respectfully asserts that Applicant's claims as amended herein are not anticipated by the Hall '783 reference particularly with respect to the simultaneous generation of at least two visually distinct warning light signals simultaneously and/or the generation of at least two visually distinct warning light signals in combination.

Applicant respectfully asserts that Applicant's claims as amended herein are allowable in view of the appropriate standard pursuant to 35 U.S.C. §102. Allowance of claims 1-3, 5, 6, 8-21, 23, 25, and new claims 26-48 herein is respectfully requested.

The Examiner next rejected claims 2-6, 9-21, 23, and 25, pursuant to 35 U.S.C. §103(a) as being unpatentable over Hall '783.

With respect to 35 U.S.C. §103, the Federal Circuit has set out at least five principles regarding obviousness determinations under §103. *Hodosh v. Block Drug Co.*, 786 F.2d 1136, 229 USPQ 182, 187 (Fed. Cir. 1986). In *Hodosh*, the Federal Circuit stated:

Our comments on the district court's obviousness determination generally include the following tenets of patent law that must be adhered to when applying §103:

- (1) the claimed invention must be considered as a whole (35 U.S.C. 103; see, e.g., *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir. 1984) (though the difference between claimed invention and prior art may seem slight, it may also have been the key to advancement of the art));
- (2) the references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481 488 (Fed. Cir. 1984));
- (3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention (e.g., *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983));
- (4) "ought to be tried" is not the standard with which obviousness is determined (*Jones, supra*, 727 F.2d at 1530, 220 USPQ at 1026); and
- (5) the presumption of validity remains constant and intact throughout litigation (35 U.S.C. 285; e.g., *American Hoist & Derrick Co. v. Sowa & Sons*,

Inc., 725 F.2d 1350, 1359-60, 220 USPQ 763, 770 (Fed. Cir. 1984)).

Furthermore, when an attempt is made to combine two references A and B, or to change a single reference, a prima facie case of obviousness has not been established if:

- (1) A and B could not or would not be physically combined in an operative fashion to produce the desired result by a person of ordinary skill without use of the patentee's teachings. *In re Lintner*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972); *In re Regel*, 526 F.2d 1399, 199 USPQ 136 (CCPA 1975); *In re Jansson*, 609 F.2d 996, 203 USPQ 976 (CCPA 1979).
- (2) The intended purpose or function of either A or B, or both, is destroyed by their combination. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).
- (3) No suggestion why or reasons or motivation for combining A and B appears explicitly or implicitly in either A or B, or both in combination. *In re Clinton*, 527 F.2d 1226, 188 USPQ 265 (CCPA 1976). Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent a teaching or suggestion supporting the combination. *In re Fine*, 5 USPQ 2d, 1596 (1988) (Fed. Cir. 1989); see also *In re Laskowski*, 10 USPQ 2d 1397 (Fed. Cir. 1989).
- (4) A and B are from such diverse arts (i.e., either or both are nonanalogous art to the claimed invention) that a person of ordinary skill in the claimed art would not look to those arts to solve the problem treated by the claimed invention. *In re Pagliaro*, 657 F.2d 1219, 210 USPQ 888 (CCPA 1981); *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979); *In re Horn*, 203 USPQ 969 (CCPA 1979).
- (5) A and B do not teach the source of the problem and the recognition of the source of the problem is what is unobvious. *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 US 45 (1923); *In re Spinnoble*, 405 F.2d 578, 160 USPQ 237 (CCPA 1969); *In re Peehs*, 612 F.2d 1287, 204 USPQ 835 (CCPA 1980). See *Kayton*, 1 Patent Practice 5-28, 29 (1985).

In addition, in the recent case of *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (CAFC 1999), the Court of Appeals for the Federal Circuit has stated that the ultimate determination of whether an invention is or is not obvious is a legal conclusion based upon underlying factual inquiries including:

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- (1) The scope and content of the prior art;
- (2) The level of ordinary skill in the prior art;
- (3) The differences between the claimed invention and the prior art; and
- (4) Objective evidence of non-obviousness.

The Court of Appeals for the Federal Circuit went on to state that the analysis with respect to obviousness is required to be conducted “at the time the invention was made” to guard against entry into the “tempting but forbidden zone of hindsight”. The Court of Appeals for the Federal Circuit went on to state that the “very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”. The Court of Appeals for the Federal Circuit has stated that the case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references and that one of ordinary skill in the art would have been motivated to select the references and combine them, and it was error to not elucidate any factual teachings, suggestions, or incentives from the prior that showed the propriety of combination. The Federal Circuit in *Dembizcak* further stated that combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability which is the essence of hindsight.

The Hall ‘783 reference teaches the use of a marker light having LED’s for use on an Amish buggy. The Hall ‘783 reference teaches the use of a flexible circuit board and the turning of a group of LED’s on and off at a desired interval to provide a flashing light. The Hall ‘783 reference further teaches an alternative for an electronic sequencer circuit for generating a light having the appearance of a rotating beacon. The Hall ‘783 reference also mentions colored LED’s.

No suggestion, motivation, or teaching is provided in the Hall ‘783 reference for use of a controller to simultaneously generate two or more visually distinct warning light signals. No suggestion, motivation, or teaching is provided in the Hall ‘783 reference for combination

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with any other reference to provide a controller for simultaneous generation of two or more visually distinct warning light signals. No suggestion, motivation, or teaching is provided in the Hall '783 reference for generation of two or more visually distinct warning light signals in combination. No suggestion, motivation, or teaching is provided in the Hall '783 reference for combination with any other reference to provide a controller utilized to generate two or more visually distinct warning light signals in combination.

In addition, no suggestion, motivation, or teaching is provided in the Hall '783 reference for use of a second panel comprising a receiving ledge adapted for positioning over said pair of opposite sides, said second panel further comprising an opaque exterior surface, said second panel constructed and arranged to secrete said light emitting diode light sources.

For the above-identified reasons, Applicant respectfully asserts that no motivation or suggestion is provided in the Hall '783 reference individually or in combination with any other reference to teach Applicant's claims herein. Further, Applicant asserts that the Hall '783 reference may not be utilized in an operative fashion to yield Applicant's invention herein. For the above-identified reasons Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. §103 rejection of Applicant's claims as amended herein. Applicant respectfully requests reconsideration and allowance of Applicant's claims herein. Issuance of an early notice of allowance is earnestly solicited. Should the Examiner have any questions concerning this Amendment and Remarks, the Examiner is cordially invited to contact the undersigned via E-Mail, facsimile, and/or by telephone and the below identified addresses. Applicant has enclosed herein a marked-up version of the claims for the convenience of the Examiner.

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Applicant again wishes to thank the Examiner for the indication of allowable subject matter as contained within claims 7, 22, and 24.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

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By: _____

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Marked-Up Version to Show Changes Made

1. (Amended) A personal warning light comprising:
 - a) a first panel having a front, [and] a back, a lip, a hinge side, a pair of parallel opposite sides, and a support side;
 - b) a plurality of light emitting diode light sources connected to said first panel, said light emitting diode light sources constructed and arranged for transmission of a light signal from said front, said light emitting diode light sources receiving power from a power source; [and]
 - c) a protector connected to said first panel for covering said light emitting diode light sources, said protector constructed and arranged to permit light passage through said protector[.]; and
 - d) a second panel constructed and arranged for releasable covering engagement of said first panel, said second panel comprising a receiving ledge adapted for positioning over said pair of opposite sides, said second panel further comprising an opaque exterior surface, said second panel constructed and arranged to secrete said light emitting diode light sources.
3. (Amended) The personal warning light according to claim [2] 1, further comprising a controller in electric communication with said light emitting diode light sources.
5. (Amended) The personal warning light according to claim [4] 1, further comprising a hinge connecting said second panel to said first panel.
6. (Amended) The personal warning light according to claim [4] 1, further comprising a plug in adaptor electrically and releasably coupled to said light emitting diode light sources.
8. (Amended) The personal warning light according to claim [4] 1, said power source comprising batteries.
9. (Amended) The personal warning light according to claim [4] 1, said reflector comprising a culminator.
10. (Amended) The personal warning light according to claim [4] 3, wherein said

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controller is in electric communication with said light emitting diode light sources, said controller being constructed and arranged to selectively activate said light emitting diode light sources thereby producing more than two different types of visually distinct warning light signals.

11. (Amended) The personal warning light according to claim [4] 1, further comprising a circuit board being constructed and arranged to position said light emitting diode light sources.

16. (Amended) The personal warning light according to claim [4] 2, said reflector comprising at least one mirror.

17. (Amended) The personal warning light according to claim [4] 3, wherein said controller is in electric communication with said light emitting diode light sources and said controller is constructed and arranged to selectively activate said light emitting diode light sources to produce a plurality of visually distinct warning light signals.

18. (Amended) The personal warning light according to claim [4] 3, wherein said controller is in electric communication with said light emitting diode light sources and said controller is constructed and arranged to independently illuminate said light emitting diode light sources.

20. (Amended) The personal warning light according to claim 19[,] further comprising a controller in electric communication with said light emitting diode light sources, wherein said controller selectively activates said light emitting diode light sources to create at least one of a single colored light signal and at least one of a multi-colored light signal.

21. (Amended) The personal warning light according to claim [4] 1, wherein said light signal is selected from the group consisting of: A revolving light, a pulsating light, an alternating light, an oscillating light, a flashing light, a stroboscopic light, a modulated light, and any combination thereof.

23. (Amended) The personal warning light according to claim [4] 1, wherein more than two different types of light signals are produced independently of each other.

25. (Amended) The personal warning light according to claim [4] 1, wherein said light



emitting diode light sources are disposed in a single row.

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